

REMARKS/ARGUMENTS

I. The Invention

The Applicant has developed a chap-styled therapeutic gradient compression stocking constructed such that it may be worn on either leg. The compression stocking includes a foot portion, a lower leg portion, an upper leg portion, a waist support and a hip portion extending between the waist support and the upper leg portion. The hip portion is formed around the lower waist of the patient and has cutouts on each side of the hip portion so that the stocking may be worn on either leg. The stocking is held in place by the waist support that includes a strap-engaging loop formed at the top of the hip portion, wherein a waist strap passes through the strap-engaging loop.

II. Claim Rejection – 35 U.S.C. § 103

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,440,665 to Russell, in view of U.S. Patent No. 3,975,929 to Fregeolle.

To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Additionally, the prior art references must teach or suggest all claim limitations. Furthermore, the teaching or suggestion to make the claimed invention must both be found in the prior art, not in applicant's disclosure. Accordingly, Examiner has failed to prove a *prima facie* case of obviousness because the references cited do not teach or suggest each and every claimed limitation nor demonstrate any suggestion to modify or combine the prior art in the manner suggested by the Examiner.

The Prior Art Does Not Teach All of the Claimed Limitations

Neither Russell nor Fregeolle, even when combined, teach or suggest each and every element of independent Claim 1. In particular, Claim 1 recites a single gradient compression stocking including a hip portion having two cutout portions such that the stocking may be worn on either leg and a waste portion constructed to accommodate a fastener surrounding the

patient's waist. Specifically, the references cited both fail to teach or suggest a single stocking with two cutout portions such that the stocking can be worn on either leg as recited in Claim 1. Furthermore, the references cited fail to teach or suggest a single stocking including a waist portion surrounding the wearer's waist.

Instead, Russell teaches a garment including a pair of attachable stockings each with one cutout located such that when attached the individual cutouts form a single opening. Examiner attempts to equate a pair of stockings each with a single cutout with a stocking with two cutouts. Additionally, the stockings described in Russell cannot be worn on either leg. Furthermore, a single stocking of the garment described in Russell is not capable of being supported independently by its own waist portion. The stockings utilized by the Russell garment require a second complementary stocking to attach to for support. Clearly, the stockings utilized in the Russell reference do not include a waist portion surrounding the user's waste. As a result, Russell does not teach or suggest each and every limitation recited in Claim 1.

The Fregeolle reference teaches a gradient compression stocking capable of being worn on either leg. However, Fregeolle entirely fails to teach or suggest a hip portion or a waist portion. Thus, similar to Russell, Fregeolle also fails to teach or suggest a gradient compression stocking including a hip portion with two cutouts and a waist portion surrounding a user's waist.

Since Russell, Fregeolle, and any combination of the two references fail to teach or suggest each an every claimed element, the claimed invention is patentable over the cited reference and the rejections under 35 U.S.C. §103 should be withdrawn. Consequently, Claim 1 and any claims dependant thereon are patentable over the cited reference.

***There Is No Suggestion or Motivation to Combine
Russell with Fregeolle***

The Examiner has failed to offer any support that the prior art, including the knowledge generally available to one of ordinary skill in the art, provides any suggestion or motivation to modify the garment described in the Russell reference with the thigh length stocking of Fregeolle to achieve the currently claimed invention. Specifically, the obviousness rejection offers mere conclusions to indicate why one of ordinary skill in the art would seek to combine the cited references. Conclusory statements are insufficient to establish a prima facie case of obviousness.

Furthermore, Russell, whether considered individually or in combination with Fregeolle, fails to provide any suggestion to modify the garment described in the Russell reference as suggested by the Examiner. The only possible source for modifying Russell to include the recited compression gradient comes from Applicants' own disclosure, which is impermissible. Thus, there is no motivation to modify Russell or combine Russell with Fregeolle in the manner as currently claimed.

The Use of Hindsight is Improper

To date, the Examiner has merely identified isolated elements from the references and combined them in an effort to reconstruct the claimed invention. What is missing is an explanation, supported by objective evidence of why one of ordinary skill in the art would be motivated to combine the cited references. Additionally, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Clearly, the references themselves contain no specific teachings that would incite someone to combine the cited references in the manner that the Examiner has asserted.

Furthermore, the absence of the necessary suggestion or motivation to combine the references requires a presumption that the combination of references selected by the Examiner to support the obviousness rejection is based on impermissible hindsight. *See In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). From the foregoing, it should be evident that hindsight reliance upon applicant's own disclosure is the only conceivable basis why one would combine the cited references. This is not a proper basis for an obviousness rejection.

Applicant has clearly shown that the requirements for establishing a *prime facie* case of obviousness under 35 U.S.C. §103 have not been met. Accordingly, the obviousness rejection should be withdrawn.

III. Conclusion

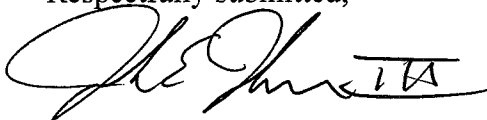
In view of the remarks made above, Applicant submits that the pending Claims are in condition for allowance. Applicant respectfully requests that the claims be allowed to issue. If

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the Examiner wishes to discuss the application or the comments herein, the Examiner is urged to contact the undersigned.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John E. Johnson, III". The signature is fluid and cursive, with a long horizontal stroke at the end.

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